REMARKS

I. Disposition of claims

Claims 1 and 23-26 are pending in the application. Non-elected claims 23-26 are provisionally withdrawn from consideration, but have been made dependent upon claim 1 for rejoinder purposes. Applicants reserve the right to file divisional applications directed to the non-elected claims of Group II.

II. Claim amendments

Independent claim 1 is amended to recite an isolated polypeptide that is immunoreactive with an antibody that is also immunoreactive with human prostatic acid phosphatase (PAP) selected from: a) an amino acid sequence of SEQ ID NO:2; and b) a variant having at least 90% identity to the amino acid sequence of a). Support for this amendment may be found in the specification, at least, for example, at page 2, lines 26-28. No new matter is added by way of these amendments. Claim 25 is amended for clarity.

III. Restriction requirement

The Examiner requires restriction to one of the following groups of allegedly distinct inventions under 35 U.S.C. 121: Group I (claim 1) directed to an isolated polypeptide as recited in claim 1, and Group II (claims 23-26) directed to a method of inducing an immune response against human PAP using a polypeptide of Group I. Applicants hereby provisionally elect for examination in the present application the claims of Group II (claims 23-26) with traverse. Reconsideration and withdrawal of the restriction between the claims of Group I and II is respectfully requested.

A. The Examiner must examine the claims of the entire application

According to MPEP 803, "[i]f the search and examination of an entire application can be made without serious burden, the examiner **must** examine it on the merits, even though it includes claims to distinct and independent inventions." *See* MPEP 803 Restriction—When Proper (*emphasis added*).

The claim of Group I is directed to an isolated polypeptide that is immunoreactive with an antibody that is also immunoreactive with human prostatic acid phosphatase (PAP) selected from: a) an amino acid sequence of SEQ ID NO:2; and b) a variant having at least 90% identity to the amino acid sequence of a). The claims of Group II are drawn to a method of inducing an immune response with a composition comprising the polypeptides of claim 1. A search and examination of these claims can be made without additional burden on the Examiner. Specifically, the claims of Group II make use of the polypeptide of claim 1. Accordingly, the invention encompassed by the claim of Group I, drawn to polypeptides, could be examined at the same time as the invention encompassed by the claims of Group II without undue burden on the Examiner, particularly in view of the searches previously made in the parent case U.S. Patent Application Serial No. 09/402,845. For example, a search of the prior art to determine the novelty of the polypeptides of Group I would provide information regarding the novelty of the method of using said polypeptide recited in Group II. Further, an updated search would not be needed as the priority date remains the same. Thus, according to the MPEP, the Examiner must examine the claims of the entire application, even though the Examiner alleges that the application include claims to distinct and independent inventions.

Applicants also submit that claims 23-26 (Group II) recite a method of using the polypeptides of claim 1 (Group I), which should be examined together with the polypeptides of claim 1, per the Commissioner's Notice in the Official Gazette of March 26, 2996, entitled "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)" which sets forth the rule, upon allowance of product claims, for rejoinder of process claims covering the same scope of products. Applicants presume these method claims will be rejoined, upon determining allowability of the product claims from which they depend.

B. The Examiner previously included the subject matter of claims 1 and 23-26 in the same group for examination purposes in the patent case

In the restriction requirement mailed March 26, 2002 in U.S. Patent Application Serial No. 09/402,845, the Examiner grouped claims 1-4 and 10-13 together for examination purposes. There, the grouped claims were drawn to the polypeptide of the

claimed invention set forth as SEQ ID NO:2, and a method of inducing an immune response with a composition comprising said polypeptide. The Examiner acknowledged that Group I forms a single general inventive concept.

In view of the relationship between the subject matter of the claims of Groups I and II, the search and examination of Groups I and II should not place a serious additional burden on the Examiner beyond what is already required with respect to the Group I claim. In any event, regardless of whether the unity of invention standard is applied, a simultaneous search of the sequence recited in claim 1 and the method of using said sequence would not impose an undue burden on the Examiner. Accordingly, Applicants respectfully request that Groups I and II be rejoined for examination in the present case.

For the reasons set forth above, reconsideration of the restriction requirement and rejoinder of the claims of Groups I and II is respectfully requested. Applicants reserve the right to file divisional applications directed to the non-elected claims of Group II.

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is encouraged to call the undersigned at (650) 838-4341.

Respectfully submitted,

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Gina Freschi
Gina Freschi
Registration No. 52,062

Correspondence Address:
Customer No. 22918